IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket No. 15038US02)

In the Application of:	Examiner: CHOWDHURY, SUMAIYA A
Jeyhan Karaoguz et al.	Group Art Unit: 2421
U.S. Patent: 7,958,525	Confirmation No.: 5576
Issue Date: June 7, 2011	
Serial No.: 10/675,466	Transmitted via the Office electronic filing system August 8, 2011.
Filed: September 30, 2003	
For: DEMAND BROADCAST CHANNELS AND CHANNEL PROGRAMMING BASED ON USER VIEWING HISTORY, PROFILING, AND REQUESTS	

APPLICATION FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(b) INDICATED IN THE PATENT (37 CFR § 1.705(d))

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

The Applicant respectfully requests reconsideration of the patent term adjustment indicated on the cover page of the patent ("the patent PTA decision"), to the extent indicated in the following discussion and the enclosed modified version of the current USPTO Patent Term Adjustment calculation on PAIR ("The Spreadsheet"). The spreadsheet and the total PTAs indicated in this paper also reflect aspects of the current USPTO Patent Term Adjustment calculation on PAIR that have already been the subject of an earlier request for recalculation under 37 CFR § 1.705(b).

This application for reconsideration of the patent PTA decision is being filed within two months after the patent issue date.

This application for reconsideration of the patent PTA decision is accompanied by the fee set forth in § 1.18(e) ($200).

This application for reconsideration of the patent PTA decision includes below a statement of the facts involved in sufficient detail to allow the United States Patent and Trademark Office (USPTO) to reach the correct patent term adjustment respecting the disputed items that arose after allowance.

The Applicant's calculation shows that the correct patent term adjustment, accounting for previously disputed and presently disputed items, should be 1321 days.

The bases under § 1.702 and 37 CFR § 1.705(d) for the adjustment are as follows.

Positive Patent Term Adjustment

Three Year Guarantee
(35 USC § 154(b)(1)(B))

The following calculation of the patent term adjustment under the three year guarantee (35 USC § 154(b)(1)(B)), first presented after the issue date of the patent, is timely because:

> The USPTO does not calculate and inform the Applicant of the patent term adjustment based upon the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) in the notice of allowance because the USPTO must know the date the patent will issue to be able to calculate the patent term adjustment based upon this provision. Thus, reconsideration of the patent term adjustment indicated in the patent as it relates to the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) is not considered a matter that could have been raised in an application for patent term adjustment under 37 CFR 1.705(b) (provides for reconsideration of the patent term adjustment indicated in the notice of allowance). Therefore, a request for reconsideration of the patent term adjustment calculation based on the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) will be considered timely under 37 CFR 1.705(d) if filed within two months of the date the patent issued.

1347 OG 49 *(Notice Concerning Calculation of the Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) involving International Applications Entering the National Stage Pursuant to 35 U.S.C. § 371)*, October 6, 2009.

The USPTO calculation of the patent term adjustment under the three-year deadline for issuing a patent after its filing date was 635 days. The Applicant disagrees with this determination because the patent term adjustment on this ground should instead be 636 days, minus 0 days consumed by an appeal, for a net adjustment of 636 days.

Specifically, the enclosed modified version of the USPTO Patent Term Adjustment calculation on PAIR shows that:

- the actual filing date of the application was September 30, 2003,
- the third anniversary of the actual filing date was September 30, 2006,
- the first request for continued examination of the application (RCE) under 35 USC 132(b) was filed on June 27, 2008.
- the first RCE was filed 636 days after the third anniversary of the actual filing date, which is the appropriate patent term adjustment on this ground.

The USPTO has established a rule respecting the endpoint of the delay under the three-year rule resulting from the filing of a request for continued examination ("RCE"): 37 CFR § 1.703(b), which states:

> The period of adjustment under § 1.702(b)is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:
> (1)The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

In short, the USPTO's position on this point is effectively that the patent term adjustment under the Three Year Guarantee (35 USC § 154(b)(1)(B)) ends on the day before the first RCE is filed. The rationale is that the day the RCE is filed is Day 1 that the patent term adjustment has stopped accumulating.

The Applicant respectfully submits that this position is inconsistent with the statute and other USPTO calculations based on events that interrupt the accumulation of patent term adjustments.

First addressing consistency with the statute, the USPTO has determined that time for purposes of assessing a PTA is calculated in two ways: one way when the statute calls for calculation of a delay or interval between two events, and the other way when the statute calls for calculation of the number of days on which a proceeding is pending. This differentiation between the two calculations is understood to turn on the words of the statute. The only part of the statute that calls for a determination of the number of days on which a proceeding is pending is 35 USC § 154(b)(1)(C), which states:

> **35 USC § 154(b)(1)(C)** GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to-
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> (i) a proceeding under section 135(a);
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> (ii) the imposition of an order under section 181; or
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> (iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

To provide a simple example, if an appeal were filed on Monday and decided on Friday, the appellate review was pending on Monday, Tuesday, Wednesday, Thursday, and Friday, thus on five days.

In contrast, the part of the statute relevant to an RCE capping the accrual of a PTA under the three year guarantee is 35 USC § 154(b)(1)(B), which states:

> **35 USC § 154(b)(1)(B)** GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including-
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> > (i) any time consumed by continued examination of the application requested by the Applicant under section 132(b);
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> > (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
> >
> > (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the Applicant except as permitted by paragraph (3)(C),
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> the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

Reverting again to the above simple example, if an appeal were filed on Monday and decided on Friday, the "time consumed by appellate review" is calculated by setting Monday equal to Day 0, Tuesday equal to Day 1, Wednesday equal to Day 2, Thursday equal to Day 3, and Friday equal 4, thus an elapsed time of FOUR, days, not FIVE as in the preceding example that called for calculation of the number of days a proceeding was pending. In other words, "time consumed by appellate review" calls for the almost universal system for calculation of deadlines in courts and the USPTO, where the starting event from which the deadline is calculated is Day 0, and the succeeding days are assigned consecutive numbers until the day the deadline is reached.

The "time consumed by continued examination," like the "time consumed by [an appeal, an interference, or a secrecy order]," all under 35 USC § 154(b)(1)(B), is expressed in different words than "each day of the pendency of

the proceeding order, or review," all under the provisions of 35 USC § 154(b)(1)(C), thus these two expressions in different parts of the same statutory section can be assumed to have different meanings as explained above.

In most situations, this is how the USPTO interprets the statute. For example, again based on USPTO petition practice experienced by the Applicant, when an appeal is prosecuted in an application that was pending more than three years, the USPTO subtracts appeal time from accrual of time under the three year guarantee by treating the date the Notice of Appeal is filed as Day 0, the date n days later when the appeal decision is mailed as Day n, simply determines that the appeal has been pending for n days, and subtracts n from the accrued time under the 3-year rule. To calculate the PTA accrued due to the prosecution of a successful appeal, however, the USPTO treats the starting date as Day 1, the date n days later when the appeal decision is mailed as Day n + 1, and determines that there were n+1 days on which the appeal was pending, and that is the PTA for appeal delay.

Now addressing consistency with other calculations, the subtraction from the three-year guarantee for an RCE is based on 35 USC § 154(b)(1)(B)(i), which calls for a subtraction based on "(i) any time consumed by continued examination of the application requested by the Applicant under section 132(b)." The subtraction from the three-year guarantee for an appeal is based on parallel language of 35 USC § 154(b)(1)(B)(ii), which calls for a subtraction based on "(ii) … any time consumed by appellate review by the Board of Patent Appeals and Interferences." This parallel language calls for RCE subtraction and appeal subtraction to be based on the same method of time computation. But they are not.

As pointed out above, the filing date of an RCE is counted as Day 1 of reduction of PTA, so time stops accruing on the three-year guarantee the day before the RCE is filed. But the filing date of a Notice of Appeal is counted as Day 0 of reduction of PTA, so time stops accruing on the three-year guarantee the day the Notice of Appeal is filed. These positions are inconsistent interpretations of the same statutory language. The RCE computation is in error

because the statute calls for routine computation of time in both situations, with the starting day of a period counted as Day 0, while the USPTO position is that the day the RCE is filed is Day 1.

Another example of an inconsistency resulting from ending the three-year delay the day before the first RCE was filed is the following. The patent term adjustment under the Three Year Guarantee permanently stops accruing or is "capped" in two situations: when the patent issues or when the first RCE is filed. Based on experience with other patent term adjustment calculations, the Applicant understands the USPTO policy respecting issue of the patent is that the issue date of the patent is Day 0 that the patent term adjustment stops accruing. In other words, the PTA on this ground is capped on the day the patent issues, not the day before the patent issues. Exactly analogously to the issue date of the patent, the date an RCE is filed is a triggering event that caps the PTA. No reason is apparent why the issue date of a patent is Day 0 on which the PTA has been capped and the filing date of an RCE is day 1 after the PTA has been capped.

For these reasons, the USPTO policy for calculation of the effect of filing an RCE on accrual of the three-year guarantee is in error, and provides a PTA one day shorter than it should be. Correction is respectfully requested.

Reductions in Patent Term Adjustment

Three Months to Pay Issue Fee (37 CFR § 1.704(b))

The Applicant is contesting the following application(s) of 37 CFR § 1.704(b) to reduce the patent term adjustment in the present application.

- The Notice of Allowance was mailed on February 1, 2011,
- The date three months after the mailing date of the Notice of Allowance is Sunday, May 1, 2011,
- The issue fee was paid on Monday, May 2, 2011,
- The reduction in the patent term adjustment proposed by the USPTO is 1 day,

- The Applicant's position is that the correct adjustment in the patent term adjustment is 0 days.

The Applicant relies primarily on 37 CFR § 1.7(a), which states in relevant part: "When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday, or a Federal holiday." Further, the statute corresponding to 37 CFR § 1.7(a), 35 U.S.C. § 21(b), states,

> When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.

37 CFR § 1.7(a) and 35 U.S.C. § 21(b) are applicable to the present facts because the last day set by statute (35 USC § 154(b)(2)(C)(ii)) for taking the action of filing a response to an Office action without being "deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application," falls on a Saturday, Sunday, or on a Federal holiday within the District of Columbia. See also 37 CFR § 1.6(a)(1), which states in relevant part, "The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia…."

Based on experience with other patent term adjustment calculations, the Applicant understands the USPTO's position on this point to be that 35 U.S.C. 154(b)(2)(C)(ii) does not require that a reply be filed in the Office within its three month grace period, but simply specifies that there is a patent term adjustment reduction if a reply is not filed within this three month period. Therefore, the "carry-over" provision of 35 U.S.C. § 21(b) does not apply to the three month period in 35 U.S.C. 154(b)(2)(C)(ii).

First, the Applicant respectfully submits that the USPTO argument interprets "the last day [ ] for taking any action" under 35 U.S.C. § 21(b) inconsistently when determining the timeliness of the Office action response respecting the need for

- a PTA reduction, versus
- a fee and petition for extension of time for response outside the shortened statutory period for response.

In the case of assessing a PTA reduction, the USPTO argued in the other application that:

> However, Applicant will note that 35 U.S.C. 154(b)(2)(C)(ii) [footnote omitted] does not require that a reply be filed in the Office within its three (3) month grace period, but simply specifies that there is a patent term adjustment reduction if a reply is not filed within this three (3) month period. Therefore, the "carry-over" provisions of 35 U.S.C. § 21(b) [footnote omitted] does not apply to the three (3) month period in 35 U.S.C. 154(b)(2)(C)(ii).

Since the reply is not "required" within three months, the USPTO held that 35 U.S.C. § 21(b) does not apply to make a response nominally due on Saturday timely on Monday.

But the USPTO reasons differently when determining whether a fee and petition for extension of time are owed for a response outside the shortened statutory period for response and short of the six-month absolute statutory deadline. For example, consider the 3-month shortened statutory period for response to an Office action. In that case, the USPTO "does not require that a reply be filed in the Office within its three (3) month grace period, but simply specifies that there is a [petition and fee for extension of time required] if a reply is not filed within this three (3) month period." Yet, when the Office action responses at issue are nominally due on Saturday but filed on Monday, in accordance with USPTO rules and policy, no petition or fee for extension of time is required. The deadline is carried over, by operation of 35 U.S.C. § 21(b), to the following business day.

The extension of time situation and the PTA reduction situation are exactly analogous, for purposes of the USPTO's argument: A response within three months is not required, although a response filed more than three months later results in a penalty. If a response is nominally due on Saturday, but filed the following Monday, no petition and fee for extension of time is required. Yet, in the same situation respecting the same Office action, a PTA reduction is assessed. To be consistent, however, the "last day [ ] for taking [ ] action" under 35 U.S.C. § 21(b) must be Saturday in each case, and carry over to Monday in each case.

The same reasoning applies to the deadlines for paying maintenance fees. The last day for paying the first maintenance fee without penalty is 3 ½ years after the patent issues. A fee can be paid later, up to four years after the patent issues, but a penalty is assessed for late payment. Yet, if the 3 ½ year deadline falls on a weekend or holiday, the payment is timely, and no fee is assessed, on the next business day.

In short, the USPTO applies the saving provision of 35 U.S.C. § 21(b) to other due dates that are not the final deadline for response, and does not apply the penalty for filing late when the nominal deadline is on a weekend or holiday and the response is filed on the next business day. Thus, to be consistent, and to correctly interpret 35 U.S.C. § 21(b), the same provision must be applied to the three-month due date for filing a response without losing days of PTA.

Second, the USPTO cannot reasonably take the position that the Applicant unreasonably delayed prosecution of the application by waiting from a weekend or holiday, when the USPTO is closed for business, until the next day when the USPTO is open for business, to file a response. Rule 1.6(a)(1) plainly states: "The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia." It is plainly inconsistent with this rule to require the Applicant to file correspondence on a Saturday to avoid losing part of the term of the patent.

Finally, there are at least two important policy reasons for allowing a response due on a Saturday, Sunday, or holiday to be filed on the next business day without finding an unreasonable delay of prosecution. One reason is that the USPTO examining staff is not required to go to work and is almost entirely absent on those days, so it would be an empty gesture to require papers to be filed on a Saturday, Sunday, or holiday, rarely to be read until the next business day. No delay of prosecution results. A second reason is that it is entirely reasonable for the Applicant to do no work and attend to his or her personal and family life on weekends, not an "unreasonable delay of prosecution." Those are the reasons why 35 U.S.C. § 21(b) was enacted, allowing that which is due on a Saturday, Sunday, or holiday to be filed on the next business day without a penalty. PTA is not really a different case, so it should be treated the same as extensions of time or the maintenance fee grace period.

Alleged Submission of a Delaying Paper After Allowance
37 CFR § 1.704(c)(10)

The applicant is contesting the following application(s) of 37 CFR § 1.704(c)(10) to reduce the patent term adjustment in the present application due to a paper filed after the Notice of Allowance has been mailed.

The USPTO is believed to be characterizing the paper filed by the Applicant entitled, "Amendment after Notice of Allowance (Rule 312)," also submitting formal drawings, on April 29, 2011, after the February 1, 2011, mailing date of the Notice of Allowance, as an alleged amendment under § 1.312 or other paper delaying prosecution. The USPTO is believed to be characterizing the issue date of the patent as the date a response was mailed to the alleged paper delaying prosecution. The reduction of PTA asserted by the USPTO is the difference between April 29, 2011, and the issue date of the patent, *plus one day*, which is 40 days. An additional applicant delay of 11 days is shown without clear reason. Thus, the Office is asserting a total reduction of 51 days due to alleged applicant delay.

The Transaction History of the patent shows the following events occurring in this application on and after April 18, 2011:

06-07-2011 Recordation of Patent Grant Mailed
05-19-2011 Email Notification
05-18-2011 Issue Notification Mailed
06-07-2011 Patent Issue Date Used in PTA Calculation
05-06-2011 Email Notification
05-05-2011 Dispatch to FDC
05-04-2011 Application Is Considered Ready for Issue
05-06-2011 Mail Response to 312 Amendment (PTO-271)
05-03-2011 Response to Amendment under Rule 312
05-02-2011 Issue Fee Payment Verified
05-02-2011 Issue Fee Payment Received
04-29-2011 Response to Reasons for Allowance
04-29-2011 Workflow - Drawings Finished
05-02-2011 Issue Fee Payment Verified
05-03-2011 Response to Amendment under Rule 312
05-02-2011 Issue Fee Payment Received
04-18-2011 Amendment after Notice of Allowance (Rule 312)

The Applicant respectfully note that although Applicant filed two (2) "Amendments after Notice of Allowance" during the time period above, only one entry, entitled "Amendment after Notice of Allowance (Rule 312)," filed April 18, 2011, appears in the Transaction History of the USPTO. Applicant respectfully submit that a first "Amendment after Notice of Allowance" was filed on April 18, 2011, which included amendments to the claims, but did not include amendments to the drawings. The Applicant filed a second "Amendment after Notice of Allowance" April 29, 2011, which was accompanied by replacement drawing sheets, and which did not amend claims. The filings of the first "Amendments after Notice of Allowance" of April 18, 2011, and the second

"Amendment after Notice of Allowance" of April 29, 2011 are shown in the Image File Wrapper of the "Private PAIR" system. However, both the Transaction History and the Image File Wrapper of the USPTO Private PAIR system list only a single "Response to Amendment under Rule 312," mailed by the Office on May 6, 2011. A review of the "Response to Amendment under Rule 312" mailed May 6, 2011 shows that it addresses amendments to claims, and does not address amendments to drawings. Therefore, Applicant concludes that the "Response to Amendment under Rule 312," mailed May 6, 2011, is in response to the entry in the Transaction History entitled, "Amendment after Notice of Allowance (Rule 312)," filed by Applicant on April 18, 2011. However, no "Response to Amendment under Rule 312" appears in either the Transaction History or the Image File Wrapper of the USPTO that corresponds to the "Amendment after Notice of Allowance" mailed April 29, 2011.

With regard to the reduction in patent term adjustment due to the first "Amendment after Notice of Allowance" filed April 18, 2011, the reduction determined according to the rule employed by the USPTO is the difference between the April 18, 2011 filing date of the first "Amendment after Notice of Allowance" and the May 6, 2011 mailing date of the "Response to Amendment under Rule 312," *plus one day*, which is 19 days. It is Applicant's position that the rule employed by the Office is in error, as will be discussed below, and that the correct reduction in patent term adjustment for the first "Amendment after Notice of Allowance," filed April 18, 2011, is 18 days.

With regard to the reduction in patent term adjustment due to the second "Amendment after Notice of Allowance," filed April 29, 2011, Applicant respectfully note that the only entry in the above list on or near April 29, 2011, is "Workflow – Drawings Finished." That entry indicates that the drawings filed on that day were fully processed on the same day. No paper was ever mailed to the applicant in response to the paper submitted on April 29, 2011. The entry dated five days later indicates, "Application is considered ready for issue," indicating no further delay occurred after that date.

37 CFR § 1.704(c)(10) states how the reduction of patent term adjustment is calculated in this situation:

> [T]he period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
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> (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
>
> (ii) Four months….

The Applicant's position is that the determination of reduction of patent term adjustment is incorrect for several reasons.

1. The USPTO never mailed a response to the second "Amendment after Notice of Allowance," filed April 29, 2011, as the rule clearly contemplates must occur for it to determine the length of the alleged delay for that filing. In other words, the rule is simply inapplicable to this situation. The mailing date of the recordation of the patent grant is not a response to the alleged paper delaying prosecution, as it does not state anything about the drawings being acceptable or unacceptable as resubmitted.
2. The USPTO made an internal notation, "Workflow - Drawings Finished," which, if mailed to the applicant would have been such a response, and clearly indicated that the last day of any alleged delay is April 29, 2011. The USPTO failure to mail a paper corresponding to its internal notation should not be the basis for continuing to count the remaining days up to issue of the patent as a further delay of prosecution. Using the USPTO calculation of the delay, the sole day of applicant delay was April 29, 2011, the day

the allegedly delaying paper was filed and the day it was processed.

3. The period of any alleged delay due to the first "Amendment after Notice of Allowance" began at filing on April 18, 2011, and ended with the May 6, 2011 mailing of the corresponding "Response to Amendment under Rule 312." As previously discussed, it is Applicant's position that the reduction in patent term adjustment on this ground is 18 days. Applicant notes, however, as discussed above, that the period of any alleged applicant delay due to the second "Amendment after Notice of Allowance" was one day, April 29, 2011, which is entirely overlapped by the time period of any alleged delay due to the first "Amendment after Notice of Allowance" that began April 18, 2011 and ended on May 6, 2011. Therefore, it is Applicant's position that no additional applicant delay due to the filing of the second "Amendment after Notice of Allowance" is appropriate.
4. The alternative delay indicated in the rule, four months, is clearly inapplicable as well, as the starting and ending dates of any alleged delay due to April 18, 2011 filing of the first "Amendment after Notice of Allowance" are clear. Further, prosecution clearly was not delayed beyond the May 4, 2011 date of the Transaction History entry entitled "Application Is Considered Ready for Issue," which is within the period of any alleged applicant delay due to the filing of the first "Amendment after Notice of Allowance," that began on April 18, 2011 and ended on May 6, 2011.
5. Finally, the rule used to determine applicant delay adds an extra day to the reduction of patent term adjustment, contrary to the statute. This is addressed under the next heading below.

Therefore, the correct amount of reduction on this basis is submitted by the Applicant to be 18 days, which is the difference between the correct filing and mailing dates of the first "Amendment under Notice of Allowance" stated above,

April 18, 2011 and May 6, 2011, respectively, but not exceeding four months. (The USPTO rule calls for a delay of 19 days in this situation, but the extra day is challenged below as contrary to the statute.)

Incorrect PTA Reduction Calculation for Paper After Allowance
37 CFR § 1.704(c)(10)

The applicant is contesting the following application(s) of 37 CFR § 1.704(c)(10) to reduce the patent term adjustment in the present application due to a paper filed after the Notice of Allowance has been mailed.

The USPTO is believed to be characterizing the new drawings filed on April 29, 2011, as a paper delaying prosecution. The USPTO is believed to be characterizing the issue date of the patent on June 7, 2011, as a response to this paper. The reduction of PTA on this basis is asserted by the USPTO is 40 days. An additional applicant delay of 11 days is shown without clear basis.

The Applicant's position is that this determination is incorrect. The amount of patent term adjustment reduction as stated above is submitted by the Applicant to be 18 days, which is the difference between the correct filing and mailing dates of the first "Amendment after Notice of Allowance" and the corresponding "Response to Amendment under Rule 312," stated above, but not exceeding four months.

The USPTO has established a rule respecting the beginning of the delay resulting from the filing of certain papers after allowance. The rule is 37 CFR § 1.704(c)(10), which states:

> (c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances,
> * * *
> (10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
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> (i)The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on

> the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
> (ii)Four months….

In short, the USPTO's position on this point is effectively that the patent term adjustment is one day longer than the difference in days between the date the post-allowance paper was filed and the date on which the USPTO responds. The rationale is that the day the paper is filed is Day 1 that the patent term adjustment has stopped accumulating.

The applicant respectfully submits that this position is inconsistent with the statute and other USPTO calculations based on events that reduce an accrued patent term adjustment.

The only part of the statute that calls for a determination of the number of days on which a proceeding is pending, as opposed to the difference between two dates, is 35 USC § 154(b)(1)(C), which states:

> **35 USC § 154(b)(1)(C)** GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to-
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> (i) a proceeding under section 135(a);
>
> (ii) the imposition of an order under section 181; or
>
> (iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

In contrast, the USPTO calculates all other patent term adjustments based on USPTO delays specified by the statute, for example under the four-month, 14-month, and three-year rules, by taking the difference between the beginning and end dates, without adding an extra day, thus counting the beginning date as day zero. The USPTO also calculates most reductions in patent term adjustment in

the same manner, for example the reduction under the three-year rule for prosecution of an appeal. Thus, the patent term adjustments for successful appeals, secrecy orders, and interferences under 35 USC § 154(b)(1)(C) are the only exceptions to the usual rule of computation of statutory periods, which is that the day on which the period begins is day 0, and the period is computed by taking the difference between the day on which the period ends and the day on which it begins.

Reverting again to the above simple example, if an appeal were filed on Monday and decided on Friday, the "time consumed by appellate review" subtracted from the delay calculated under the three-year rule is calculated by setting Monday equal to Day 0, Tuesday equal to Day 1, Wednesday equal to Day 2, Thursday equal to Day 3, and Friday equal 4, thus an elapsed time of FOUR, days, not FIVE as in the preceding example that called for calculation of the number of days a proceeding was pending. In other words, "time consumed by appellate review" subtracted from the delay calculated under the three-year rule calls for the almost universal system for calculation of deadlines in courts and the USPTO, where the starting event from which the deadline is calculated is Day 0, and the succeeding days are assigned consecutive numbers until the day the deadline is reached.

For these reasons, the USPTO policy for calculation of the effect of filing a post-allowance paper on accrual of the three-year guarantee is in error, and provides an applicant delay one day longer than it should be, thus a PTA one day shorter than it should be. Correction is respectfully requested.

Net Patent Term Adjustment

The changes requested by the Applicant to the USPTO patent term adjustment determination in the patent PTA decision are as follows:

Positive Patent Term Adjustment

- **Three Year Guarantee (35 USC § 154(b)(1)(B))**

	Patent Term Adjustment (days)
USPTO Calculation	635
Applicant Calculation	636

Reductions in Patent Term Adjustment

- **Three Months to Pay Issue Fee (37 CFR § 1.704(b))**

	Patent Term Adjustment (days)
USPTO Calculation	1
Applicant Calculation	0

- **Alleged Submission of a Delaying Paper After Allowance**

37 CFR § 1.704(c)(10)

	Patent Term Adjustment (days)
USPTO Calculation	51
Applicant Calculation	18

Conclusion

The Applicant requests modification of the patent term adjustment as indicated above. As shown in the enclosed modified version of the USPTO

Patent Term Adjustment calculation on PAIR, the patent term adjustment proposed by the Applicant is thus 1321 days.

Please charge any fees or credit any overpayment of fees presently required to McAndrews, Held & Malloy, Ltd., Deposit Account No. 13-0017.

Respectfully submitted,

McANDREWS, HELD & MALLOY, LTD.

Date: August 8, 2011

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